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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/570,739

09/14/2006

Kazuhiro Hama

CU-4717 RJS

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26530 7590 01/30/2009  
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EXAMINER

ROBINSON, ELIZABETH A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/570,739	<b>Applicant(s)</b> HAMA ET AL.	
	<b>Examiner</b> Elizabeth Robinson	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4 is/are pending in the application.  
     4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2 and 3 are currently being examined.

### ***Election/Restrictions***

Newly submitted claim 4 is directed to an invention that lacks unity with the invention originally claimed for the following reasons:

Claim 4 and originally presented claim 1 share the same technical feature, the decorative paper as in originally presented claim 1. However, the decorative paper of originally presented claim 1 does not exhibit "special technical features", because it does not make a contribution over the prior art.

Handforth (US 4,402,262) (Column 2, lines 7 through 25) teaches printing an ink composition comprised of two polymers (A and B) and a pigment on a substrate. The substrate can be paper (Column 3, lines 43 through 51). When the substrate is paper, the primary polymer A can be a methyl methacrylate (an acrylic resin) (Column 4, lines 45 through 58). Polymer B can be a polyurethane-containing resin (urethane resin) (Column 3, lines 56 through 60). The pigment can be a pearlescent pigment, which the Examiner is considering to be a scaly foil of a bright pigment (Column 9, lines 1 through 10). The ink can be printed on the paper using gravure printing (Column 5, lines 56 through 59). An ink layer can be printed over another ink layer of a different

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composition (Column 6, lines 24-43 and Example 4). The lower ink layer can be considered to be a pattern ink layer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 4 is withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

**Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handforth (US 4,402,262), in view of Schnee et al. (US 3,936,547).**

Handforth (Column 2, lines 7 through 25) teaches printing an ink composition comprised of two polymers (A and B) and a pigment on a substrate. The substrate can be paper (Column 3, lines 43 through 51). When the substrate is paper, the primary polymer A can be a methyl methacrylate (an acrylic resin) (Column 4, lines 45 through 58). Polymer B can be a polyurethane-containing resin (urethane resin) (Column 3, lines 56 through 60). The pigment can be a pearlescent pigment, which the Examiner is considering to be a scaly foil of a bright pigment (Column 9, lines 1 through 10). The ink can be printed on the paper using gravure printing (Column 5, lines 56 through 59). Handforth (Column 3, lines 3 through 12) further teaches that the urethane component in the ink binder is an adhesion promoter in an aqueous composition. An ink layer can be printed over another ink layer of a different composition (Column 6, lines 24-43 and Example 4). The lower ink layer can be considered to be a pattern ink layer.

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Handforth does not teach impregnating the paper with a resin and curing.

Schnee (Column 1, lines 40 through 43) teaches a process for impregnating paper with a melamine resin solution and then drying (curing). Melamines are thermoset resins. Schnee (Column 2, lines 58 through 65) further teaches that the impregnated paper can be a decorative paper. The melamine impregnation solution contains water or water-miscible solvents, in order to easily and deeply impregnate the paper substrate (Column 2, lines 1 through 7).

It would be obvious to one of ordinary skill in the art to use the decorative paper of Handforth, as the paper to be impregnated by the melamine resin of Schnee, because the urethane binder would maintain adhesion of the ink in the aqueous melamine resin.

### ***Response to Arguments***

Applicant's arguments filed November 5, 2008 have been fully considered but they are not persuasive.

Applicant argues that that Handforth (US 4,402,262) does not teach a pattern ink layer. However, as stated above, Handforth teaches that an ink layer can be printed over another ink layer of a different composition. The lower ink layer can be considered to be a pattern ink layer. Since the pigments can be different in the two layers, the lower ink layer can be a pigmented layer with no bright pigments. Further, in response to applicant's argument that the pattern ink layer should not contain bright pigments, it is noted that this features is not recited in the rejected claims. Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Due to amendment to the claims, the 35 U.S.C., second paragraph rejection from the March 18, Office Action is withdrawn.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Robinson whose telephone number is (571)272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. R./  
Elizabeth Robinson  
Examiner, Art Unit 1794

/D. Lawrence Tarazano/  
Supervisory Patent Examiner, Art  
Unit 1794

January 21, 2009